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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/559,851	12/02/2005	Michael Andrew Singer	3001	7427

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Albert Brent
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EXAMINER

BEKKER, KELLY JO

ART UNIT	PAPER NUMBER
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1794

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07/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/559,851	Applicant(s) SINGER, MICHAEL ANDREW	
	Examiner Kelly Bekker	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 and 23-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 22 and 30-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION
Election/Restrictions

Applicant's election with traverse of Groups I-IV in the reply filed on February 19, 2009 is acknowledged. The traversal is on the ground(s) that the technical feature linking the groups as it is a special technical feature because it is powdered and the reference cited by the examiner is a juice. This is not found persuasive because only one group claims the sweetener as a powder, thus the linking feature between the groups does not include the sweetener as a powder. As stated in the previous office action, the technical feature linking the groups, the use of Lo Han Kuo extract as a sweetener in foods, was not a special technical feature as it was known as taught by Sarama et al (US 2003/0045473 A1). Claims 17-20 and 23-29 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21, 22 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely

exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 21 and 30 recites the broad recitation 45.6-45.8% Lo Han Kuo Extract and 54.4-54.2% Sucralose Powder, and the claim also recites 45.7% Lo Han Kuo Extract and 54.3% Sucralose Powder which is the narrower statement of the range/limitation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21, 22, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nestelle (WO 01/28357 A2) as evidenced by China (China Natural Products Group inc, Lo Han Kuo Extract from Fresh Fruit page 1).

Nestelle teaches of a sweetener composition comprising Lo Han Kuo extract in powdered form (page 5 lines 6-21), sucralose (Page 5 line 30 through page 6 line 2), and other carbohydrate sweeteners (page 6 lines 8-20). Nestelle teaches that the amount of the sweetener will depend on the relative sweetness which the sweetener has and the desired sweetness of the final product and that one of ordinary skill in the art would be able to easily determine an appropriate amount (page 6 lines 3-7, 19-20, and 26-27). Nestelle teaches that the sweeteners of the invention are used in food materials including confections, candies, bakes goods, beverages and frozen foods (page 6 line 29 through page 7 line 18).

Note: Sucralose is defined as having the chemical formula of $C_{12}H_{19}O_8Cl_3$, thus as Nestelle teaches of using sucralose in unaltered form, Nestelle teaches of sucralose with the chemical formula $C_{12}H_{19}O_8Cl_3$.

Note: As evidenced by China, Lo Han Kuo Extract is defined as containing 80% or greater mogroside (page 1) which is made from Momordica fruit, thus as Nestelle teaches of using Lo Han Kuo Extract in unaltered form, Nestelle teaches of Lo Han Kuo Extract with at least 80% mogroside made from Momordica fruit.

Nestelle is silent to the percentage of Lo Han Kuo Extract as 45.6-45.8% and the percentage of sucralose as 54.2-54.4% as recited in claims 21 and 30, and to the ratio of Lo Han Kuo Extract to Sucralose powder as 0.81-0.84 as recited in claim 31.

Regarding the percentage of Lo Han Kuo Extract as 45.6-45.8%, the percentage of sucralose as 54.2-54.4%, and the ratio of Lo Han Kuo Extract to Sucralose powder as 0.81-0.84, Nestelle teaches Lo Han Kuo Extract and Sucralose in combination with one another in a sweetener composition. One would have been motivated to vary the amounts of each respective sweetener and thus the ratio of the sweeteners based upon the final sweetness desired in the final composition and the texture/bulk of the final composition. To do so would be easily determined by one of ordinary skill in the art at the time the invention was made as taught by Nestelle. As the variation of the sweeteners would be based upon their known function, such an alteration would not impart a patentable distinction to the claims absent any clear and convincing arguments and/or evidence to the contrary.

Claims 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nestelle (WO 01/28357 A2) as evidenced by China (China Natural Products Group inc, Lo Han Kuo Extract from Fresh Fruit page 1), further in view of Parker et al (Developments in Sweeteners 2, page 239).

Nestelle teaches of a sweetener composition as discussed above. Nestelle is silent to the sweetener as comprising a polydextrose as recited in claim 32.

Parker et al (Parker) teaches that when used in the food industry, such as in baked goods, traditional non-nutritive sweeteners, such as sucralose do not provide for the same bulking as traditional sweeteners. Parker teaches that with the use of polydextrose non-nutritional sweeteners are used that are capable of providing the bulk of traditional sweeteners (page 239).

Regarding the sweetener as comprising polydextrose, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include polydextrose in the sweetener composition of Nestelle in view of Parker. One would have been motivated to do so in order for the sweetener taught by Nestelle to mimic the bulk of a traditional sweetener when used in foods as taught by Parker.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21, 22, 30 and 31 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,773,743 B1 ('743). Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards sweetening compositions of baked goods, ice cream, and candies comprising Lo Han Kuo powdered extract comprising at least 80% mogroside which is from *Momordica* fruit and Sucralose C₁₂H₁₉O₈Cl₃. The only difference is '743 teaches that the sucralose in liquid form and the instantly claimed invention is directed towards a powder. Claim 2

of '743 teaches that the liquid sucralose contains 24.5-25.6% sucralose powder, thus the liquid composition as claimed by '743 consists of 19.9-21.4% sucralose powder, 16.3-18.4% Lo Han Kuo Extract, and water. The ratio as claimed by '743 of Lo Han Kuo Extract Powder to Sucralose Powder is 0.76 to 0.92 which encompasses the instantly claimed range of 0.81 to 0.84. The dry weight basis of '743 for Lo Han Kuo Extract Powder and Sucralose Powder is about 43.2-48.0% Lo Han Kuo Extract Powder and about 52.5%-56.7% Sucralose Powder which encompasses the dry range of 45.6-45.8% Lo Han Kuo Extract Powder and 54.2-54.4% Sucralose Powder as instantly claimed. One would have been motivated for the liquid sweetener as claimed by '743 to be in powdered form so that it would have a longer storage life. To do so would be common sense to one of ordinary skill in the art at the time the invention was made and would not impart a patentable distinction to the claims.

Claim 32 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,773,743 B1 ('743) in view of Parker et al (Developments in Sweeteners 2, page 239). Although the conflicting claims are not identical, they are not patentably distinct from each other because both are directed towards sweetening compositions of baked goods, ice cream, and candies comprising Lo Han Kuo powdered extract comprising at least 80% mogroside which is from Momoridica fruit and Sucralose $C_{12}H_{19}O_8Cl_3$. The only difference is '743 does not teach the addition of polydextrose to the sweetener composition.

Parker et al (Parker) teaches that when used in the food industry, such as in baked goods, traditional non-nutritive sweeteners, such as sucralose do not provide for the same bulking as traditional sweeteners. Parker teaches that with the use of polydextrose non-nutritional sweeteners are used that are capable of providing the bulk of traditional sweeteners (page 239).

Regarding the sweetener as comprising polydextrose, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include polydextrose in the sweetener composition of '743 in view of Parker. One would have

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been motivated to do so in order for the sweetener taught by '743 to mimic the bulk of a traditional sweetener when used in foods as taught by Parker.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Bekker whose telephone number is (571) 272-2739. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lien Tran/
Primary Examiner
Art Unit 1794

/Kelly Bekker/
Examiner
Art Unit 1794